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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/044,696	11/01/2001	Michihiro Ota	84042	1278

7590 04/07/2004

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EXAMINER	
YOUNG, JOHN L	

ART UNIT	PAPER NUMBER
3622	

DATE MAILED: 04/07/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)
	10/044,696	OTA ET AL.
	Examiner	Art Unit
	John L Young	3622

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *01 November 2001*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-11* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-11* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☒ All b)☐ Some * c)☐ None of:

1.☒ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

4-5-05

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date *3*.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

FIRST ACTION REJECTION

DRAWINGS

1. This application has been filed with drawings that are considered informal; however, said drawings are acceptable for examination and publication purposes. The review process for drawings that are included with applications on filing has been modified in view of the new requirement to publish applications at eighteen months after the filing date of applications, or any priority date claimed under 35 U.S.C. §§119, 120, 121, or 365.

CLAIM REJECTIONS – 35 U.S.C. §101

35 U.S.C. §101 reads as follows:

> Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter or any new and useful improvement thereof, may obtain a patent therefore, subject to the conditions and requirements of this title.

2. Claims 1-11 are rejected under 35 U.S.C. 101, because said claims are directed to non-statutory subject matter.

As per claims 1-11, as drafted said claims are not within the technological arts (see *In re Waldbaum*, 173 USPQ 430 (CCPA 1972); *In re Musgrave*, 167 USPQ 280 (CCPA 1970) and *In re Johnston*, 183 USPQ 172 (CCPA 1974) also see MPEP 2106 IV 2(b) even though said claims may be limited by language to a useful, concrete and

tangible application (See *State Street v. Signature financial Group*, 149 F.3d at 1374-75, 47 USPQ 2d at 1602 (Fed Cir. 1998) ; *AT&T Corp. v. Excel*, 50 USPQ 2d 1447, 1452 (Fed. Cir. 1999).

Note: it is well settled in the law that "[although] a claim should be interpreted in light of the specification disclosure, it is generally considered improper to read limitations contained in the specification into the claims. See *In re Prater*, 415, F.2d 1393, 162 USPQ 541 (CCPA 1969) and *In re Winkhaus*, 527 F.2d 637, 188 USPQ 129 (CCPA 1975), which discuss the premise that one cannot rely on the specification to impart limitations to the claims that are not recited in the claims." (See MPEP 2173.05(q)).

Also, in this case, the claim language is merely non-functional descriptive material disembodied from the technological arts.

CLAIM REJECTION — 35 U.S.C. §103(a)

The following is a quotation of 35 U.S.C. §103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been

obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

3. Claims 1-11 are rejected under 35 U.S.C. §103(a) as being unpatentable over Eggleston 6,061,660; class 705/14, (May 9, 2000) [US f/d: 3/18/1998] (herein referred to as "Eggleston").

As per claim 1, Eggleston (the ABSTRACT; FIG. 1; FIG. 10; FIG. 11; FIG. 12; FIG. 13; FIG. 14; FIG. 15; FIG. 16; FIG. 17; FIG. 18; FIG. 2; FIG. 3; FIG. 4; FIG. 5; FIG. 6; FIG. 7; FIG. 8; FIG. 9; col. 1, ll. 12-67; col. 2, ll. 1-67; col. 3, ll. 1-67; col. 4, ll. 1-63; col. 5, ll. 7-67; col. 6, ll. 1-67; col. 7, ll. 1-67; col. 8, ll. 1-67; col. 9, ll. 1-67; col. 10, ll. 1-67; col. 11, ll. 1-67; col. 12, ll. 1-67; col. 13, ll. 1-67; col. 14, ll. 1-67; col. 15, ll. 1-67; and col. 16, ll. 1-59; col. 17, ll. 1-67; col. 18, ll. 1-67; col. 19, ll. 1-67; col. 20, ll. 1-67; col. 21, ll. 1-67; and col. 22, ll. 1-10; and whole document) shows the method of claim 1.

Eggleston lacks an explicit recital of the elements of claim 1 even though Eggleston shows same. It would have been obvious to one of ordinary skill in the art at the time of the invention that Eggleston (the ABSTRACT; FIG. 1; FIG. 10; FIG. 11; FIG. 12; FIG. 13; FIG. 14; FIG. 15; FIG. 16; FIG. 17; FIG. 18; FIG. 2; FIG. 3; FIG. 4; FIG. 5; FIG. 6; FIG. 7; FIG. 8; FIG. 9; col. 1, ll. 12-67; col. 2, ll. 1-67; col. 3, ll. 1-67; col. 4, ll. 1-63; col. 5, ll. 7-67; col. 6, ll. 1-67; col. 7, ll. 1-67; col. 8, ll. 1-67; col. 9, ll. 1-67; col. 10, ll. 1-67; col. 11, ll. 1-67; col. 12, ll. 1-67; col. 13, ll. 1-67; col. 14, ll. 1-67; col. 15, ll.

1-67; and col. 16, ll. 1-59; col. 17, ll. 1-67; col. 18, ll. 1-67; col. 19, ll. 1-67; col. 20, ll. 1-67; col. 21, ll. 1-67; and col. 22, ll. 1-10; and whole document) would have been selected in accordance with the elements and limitations of claim 1 because claim 1 suffers from undue breadth and because selection of such features would have provided means *"to permit sponsors to build, buy, store, modify, offer, track and administer incentive programs and to permit sponsors and retailers to offer improved award fulfillment for participants in incentive programs. . . ."* (see Eggleston (col. 5, ll. 45-55)).

As per dependent claims 2-7, Eggleston (the ABSTRACT; FIG. 1; FIG. 10; FIG. 11; FIG. 12; FIG. 13; FIG. 14; FIG. 15; FIG. 16; FIG. 17; FIG. 18; FIG. 2; FIG. 3; FIG. 4; FIG. 5; FIG. 6; FIG. 7; FIG. 8; FIG. 9; col. 1, ll. 12-67; col. 2, ll. 1-67; col. 3, ll. 1-67; col. 4, ll. 1-63; col. 5, ll. 7-67; col. 6, ll. 1-67; col. 7, ll. 1-67; col. 8, ll. 1-67; col. 9, ll. 1-67; col. 10, ll. 1-67; col. 11, ll. 1-67; col. 12, ll. 1-67; col. 13, ll. 1-67; col. 14, ll. 1-67; col. 15, ll. 1-67; and col. 16, ll. 1-59; col. 17, ll. 1-67; col. 18, ll. 1-67; col. shows the method of claim 1 and subsequent base claims depending from claim 1.

Eggleston lacks explicit recitation of the elements and limitations of claims 2-7, even though the disclosure of Eggleston reasonably shows same.

Official Notice is taken that both the concepts and the advantages of the elements and limitations of claims 2-7 were notoriously well known and expected in the art at the time of the invention. It would have been obvious to a person of ordinary skill in the art at the time of the invention to include the elements and limitations of claims 2-7, because said claims suffer from undue breadth and because selection of such features would have

provided means *"to permit sponsors to build, buy, store, modify, offer, track and administer incentive programs and to permit sponsors and retailers to offer improved award fulfillment for participants in incentive programs. . . ."* (see Eggleston (col. 5, ll. 45-55)).

Independent claim 8 is rejected for substantially the same reasons as independent claim 1.

As per dependent claim 9, Eggleston (the ABSTRACT; FIG. 1; FIG. 10; FIG. 11; FIG. 12; FIG. 13; FIG. 14; FIG. 15; FIG. 16; FIG. 17; FIG. 18; FIG. 2; FIG. 3; FIG. 4; FIG. 5; FIG. 6; FIG. 7; FIG. 8; FIG. 9; col. 1, ll. 12-67; col. 2, ll. 1-67; col. 3, ll. 1-67; col. 4, ll. 1-63; col. 5, ll. 7-67; col. 6, ll. 1-67; col. 7, ll. 1-67; col. 8, ll. 1-67; col. 9, ll. 1-67; col. 10, ll. 1-67; col. 11, ll. 1-67; col. 12, ll. 1-67; col. 13, ll. 1-67; col. 14, ll. 1-67; col. 15, ll. 1-67; and col. 16, ll. 1-59; col. 17, ll. 1-67; col. 18, ll. 1-67; col. shows the system of claim 8.

Eggleston lacks explicit recitation of the elements and limitations of claim 9, even though the disclosure of Eggleston reasonably shows same.

Official Notice is taken that both the concepts and the advantages of the elements and limitations of claim 9 were notoriously well known and expected in the art at the time of the invention. It would have been obvious to a person of ordinary skill in the art at the time of the invention to include the elements and limitations of claim 9, because said claim suffers from undue breadth and because selection of such features would have

provided means *"to permit sponsors to build, buy, store, modify, offer, track and administer incentive programs and to permit sponsors and retailers to offer improved award fulfillment for participants in incentive programs. . . ."* (see Eggleston (col. 5, ll. 45-55)).

Independent claim 10 is rejected for substantially the same reasons as independent claim 1.

As per dependent claim 11, Eggleston (the ABSTRACT; FIG. 1; FIG. 10; FIG. 11; FIG. 12; FIG. 13; FIG. 14; FIG. 15; FIG. 16; FIG. 17; FIG. 18; FIG. 2; FIG. 3; FIG. 4; FIG. 5; FIG. 6; FIG. 7; FIG. 8; FIG. 9; col. 1, ll. 12-67; col. 2, ll. 1-67; col. 3, ll. 1-67; col. 4, ll. 1-63; col. 5, ll. 7-67; col. 6, ll. 1-67; col. 7, ll. 1-67; col. 8, ll. 1-67; col. 9, ll. 1-67; col. 10, ll. 1-67; col. 11, ll. 1-67; col. 12, ll. 1-67; col. 13, ll. 1-67; col. 14, ll. 1-67; col. 15, ll. 1-67; and col. 16, ll. 1-59; col. 17, ll. 1-67; col. 18, ll. 1-67; col. shows the system of claim 10.

Eggleston lacks explicit recitation of the elements and limitations of claim 11, even though the disclosure of Eggleston reasonably shows same.

Official Notice is taken that both the concepts and the advantages of the elements and limitations of claim 11 were notoriously well known and expected in the art at the time of the invention. It would have been obvious to a person of ordinary skill in the art at the time of the invention to include the elements and limitations of claim 11, because said claim suffers from undue breadth and because selection of such features would have

provided means *"to permit sponsors to build, buy, store, modify, offer, track and administer incentive programs and to permit sponsors and retailers to offer improved award fulfillment for participants in incentive programs. . . ."* (see Eggleston (col. 5, ll. 45-55)).

CONCLUSION

4. Any response to this action should be mailed to:

Commissioner for Patents

P. O. Box 1450

Alexandria, VA 22313-1450

Any response to this action may be sent via facsimile to either:

(703) 746-7239 or (703) 872-9314 (for formal communications EXPEDITED PROCEDURE) or (703) 746-7239 (for formal communications marked AFTER-FINAL) or

(703) 746-7240 (for informal communications marked PROPOSED or DRAFT).

Hand delivered responses may be brought to:

Seventh floor Receptionist
Crystal Park V
2451 Crystal Drive
Arlington, Virginia.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to John L. Young who may be reached via telephone at (703) 305-

3801. The examiner can normally be reached Monday through Friday between 8:30 A.M. and 5:00 P.M.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eric Stamber, may be reached at (703) 305-8469.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 305-3900.

John L. Young

JOHN LEONARD YOUNG, ESQ.
PRIMARY EXAMINER

Primary Patent Examiner

April 5, 2004